

## REMARKS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 1-26 remain pending in the case. Claims 1-26 are rejected.

### 35 U.S.C. §103(a)

Claims 1-3 and 5-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 6,059,842 by Dumarot et al., hereinafter referred to as the "Dumarot" reference. Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1-3 and 5-13 are not rendered obvious by Dumarot.

Applicants respectfully direct the Examiner to independent Claim 1 that recites that an embodiment of the present invention is directed to (emphasis added):

A method for enhancing performance of a computer system, comprising:

electronically deriving relationships over time between monitored system variables and monitored performance of said computer system;

automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and

adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system.

Independent Claim 12 recites similar limitations. Claims 2,3 and 5-11 that depend from independent Claim 1 and Claim 13 that depends from independent Claim 12 provide further recitations of the features of the present invention.

Dumarot and the claimed invention are very different. Applicants understand Dumarot to teach a system and method for optimizing computer software and hardware according to user-specified preferences (Abstract; col. 3, lines 10-13; and col. 3, lines 41-45). In particular, Dumarot teaches that rules are used to make the optimizations, wherein the rules are selected according to a user selection. The computer optimization system as taught by Dumarot does not teach, describe or suggest “electronically deriving relationships over time between monitored system variables and monitored performance of said computer system,” as claimed (emphasis added).

With reference to Figure 5 of Dumarot, the optimizer contains rules 331, 341 and 351 that are used for making optimizations 330 and 340, and recommendations 350, respectively (col. 7, lines 25-27). Applicants understand the rules to be preconfigured and are selected according to a user's interaction with a graphical user interface (GUI). Applicants respectfully assert that the rules of Dumarot are not based on derived relationships between system variables and the performance of the computer.

With reference to Figure 1 of Dumarot, icons representing rules are selected “from a set of available rules by the user and dragged 68 to an icon 69 representing the optimizer 136 so that the optimizer will implement 330, 340, 350 the rules” (col. 7, lines 50-53). Accordingly, Applicants respectfully assert that the rules as described in Dumarot are preconfigured and are not generated based on monitoring system variables and performance. Moreover, Dumarot teaches that a user selects the rules for implementation. Specifically, with reference to Figure 6 of Dumarot, the particular placement of a rule icon affects how the optimizer implements the rules (col. 8, line 26 through col. 9, line 4). The placement of the rule is a made by a user.

Examiner asserts that the rules of Dumarot may be generated without requiring human interaction. Applicants respectfully submit that the rules of Dumarot are user-defined, and thus require human interaction. With reference to Figures 6 and 7, the placement of a rule icon determines whether a rule is applied (col. 8, line 28 through col. 9, line 39). For example, if the rule icon 540 is moved by a user within a threshold distance 590 from optimizer icon 510, the rule is applied, as shown at step 660 of Figure 7 (col. 9, lines 8-15). In particular, the selection rules how the rules are applied, as taught in Dumarot, requires human interaction. Moreover, Dumarot teaches a GUI for selecting and applying rules.

Furthermore, Examiner asserts that the “rules are automatically generated after the user selects the rules” in the Detailed Action (see the last two lines of paragraph 3 of the Detailed Action). Applicants are unclear how a preconfigured user-selected rule

can automatically be generated in response to a user-selection. Applicants respectfully assert that the rules of Dumarot are applied in response to a user-selection, and therefore are not generated automatically.

Applicants understand Dumarot to teach a system and method for optimizing computer software and hardware according to user-selected rules. Moreover, Applicants understand Dumarot to teach that the placement of the rules on the GUI (e.g., closeness) is used to determine how the rules are implemented. Specifically, the rules are not generated based on derived relationships of system variables and computer performance. While Dumarot does teach that the optimizer monitors system behavior, this monitoring is used for performing actions dictated by the rules, not for deriving relationships or generating rules.

In contrast, embodiments of the claimed invention are directed towards a method for enhancing performance of a computer system, including "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system", as claimed (emphasis added). With reference to With reference to Figure 5 of the present application, a number of rules 500-502 are generated based on an analysis of acquired data for system variables and system performance, and the derived relationships therebetween (page 14, lines 7-16). The rules are generated based on an analysis data acquired (page 13, lines 7-22). In particular, the relationships are derived between system variables and the performance of the computer system, and are not user-defined.

Applicants respectfully assert that Dumarot in particular does not teach, disclose, or suggest the invention as claimed. In contrast, Dumarot discloses a system and method for optimizing computer software and hardware according to user-selected rules, and implements the rules according to how the icon representing the rule is placed in the GUI. By teaching a system that utilizes and requires a user to select and place rules for the rules to be applied, wherein the rules are pre-configured, Dumarot teaches away from the claimed invention.

Applicants respectfully assert that nowhere does Dumarot teach, disclose or suggest the claimed embodiments of the present invention as recited in independent Claims 1 and 12, and that these claims overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance. Therefore, Applicants respectfully submit that Dumarot also does not teach, disclose or suggest the additional claimed features of the present invention as recited in Claims 2, 3 and 5-11 that are dependent on allowable base Claim 1 and Claim 13 that is dependent on allowable base Claim 12. Applicants respectfully submit that Claims 2, 3, 5-11 and 13 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dumarot in view of the English Abstract of Japanese Patent 403010379 by Mihata et al., hereinafter referred to as the "Mihata" reference. Claim 4 depends from

independent Claim 1. Applicants have reviewed the cited reference and respectfully submit that the embodiment of the present invention as recited in Claim 4 is not rendered obvious by the combination of Dumarot in view of Mihata.

As described above, Dumarot does not teach describe or suggest the embodiments of the present invention recited in Claim 1. Moreover, the combination of Dumarot and Mihata fails to teach or suggest the claimed embodiments because Mihata does not overcome the shortcomings of Dumarot. Applicants understand Mihata to teach a design rules verifying system. Mihata, alone or in combination with Dumarot, does not show or suggest a method for enhancing performance of a computer system, including "electronically deriving relationships over time between monitored system variables and monitored performance of said computer system", as claimed.

Applicants respectfully assert that nowhere does the combination of Dumarot and Mihata, disclose or suggest the present invention as recited in independent Claim 1, and that Claim 1 is thus in condition for allowance. Therefore, Applicants respectfully submit that the combination of Dumarot and Mihata also does not teach or suggest the additional claimed features of the present invention as recited in Claim 4 that is dependent on allowable base Claim 1. Applicants respectfully submit that Claim 4 overcomes the rejection under 35 U.S.C. § 103(a) as this claim is dependent on an allowable base claim.

Applicants respectfully point out that the rejections based only on Mihata are based only on the Abstract of Mihata, which is the only portion of Mihata that is translated into English. “Citations of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art. … It is our opinion that a proper examination under 37 CFR §1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document.” *Ex parte Jones*, 62 USPQ2d 1206, 1208 (B.P.A.I. 2001). “In our view, obtaining translations is the responsibility of the examiner. A review by the examiner and applicant of translations of the prior art relied upon in support of the examiner’s rejection may supply additional relevant evidence as to whether there is a legally sufficient reason, suggestion, teaching or motivation to combine the teachings .... *Ex parte Jones*, 62 USPQ2d 1206, 1208-09 (B.P.A.I. 2001); MPEP 706.02.

In the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

Claims 14, 15 and 17-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dumarot in view of United States Patent 5,729,472 by Seiffert et al., hereinafter referred to as the “Seiffert” reference. Applicants have reviewed the cited

references and respectfully submit that the embodiments of the present invention as recited in Claims 14, 15 and 17-26 are not rendered obvious by the combination of Dumarot in view of Seiffert.

Applicants respectfully direct the Examiner to independent Claim 14 that recites that an embodiment of the present invention is directed to (emphasis added):

An apparatus for enhancing performance of a computer system, comprising:

computer readable storage media;

computer readable program code stored on said computer readable storage media, comprising:

program code for deriving relationships between system variables and the performance of said computer system;

program code for automatically generating a number of rules based on said derived relationships, wherein said number of rules are generated without requiring human interaction; and

program code for adjusting at least one of said system variables based on said generated number of rules to enhance the performance of said computer system.

Independent Claim 24 recites similar limitations. Claims 15 and 17-23 that depend from independent Claim 14 and Claims 25 and 26 that depend from independent Claim 24 provide further recitations of the features of the present invention.

As described above, Applicants understand Dumarot to teach a system and method for optimizing computer software and hardware according to pre-configured and user-selected rules. Moreover, Applicants understand Dumarot to teach that the placement of the rules on the GUI (e.g., closeness) is used to determine how the

rules are applied and implemented. Specifically, the rules are not based on derived relationships between system variables and the performance of the computer system.

In contrast, embodiments of the claimed invention are directed towards an apparatus for enhancing performance of a computer system, including “program code for deriving relationships between system variables and the performance of said computer system,” as claimed (emphasis added). In particular, the relationships are derived between system variables and the performance of the computer system, and are not user-defined.

Applicants respectfully assert that Dumarot in particular does not teach, disclose, or suggest the invention as claimed. In contrast, Dumarot discloses a system and method for optimizing computer software and hardware according to user-selected rules, and implements the rules according to how the icon representing the rule is placed in the GUI. By teaching a system that utilizes and requires a user to select and place rules for the rules to be applied, wherein the rules are pre-configured, Dumarot teaches away from the claimed invention.

Moreover, the combination of Dumarot and Seiffert fails to teach or suggest the claimed embodiments because Seiffert does not overcome the shortcomings of Dumarot. Seiffert, either alone or in combination with Dumarot, does not show or suggest an apparatus for enhancing performance of a computer system, including

“program code for deriving relationships between system variables and the performance of said computer system”, as claimed (emphasis added).

Applicants understand Seiffert to teach a method and system for monitoring a computer system using watchdog rules. In particular, the watchdog rules are defined by a system administrator for evaluating watchdog checks, which are also defined by the system administrator (col. 6, lines 15-18 and lines 30-36). In contrast, embodiments of the claimed invention are directed towards an apparatus for enhancing performance of a computer system, including “program code for deriving relationships between system variables and the performance of said computer system”, as claimed (emphasis added). In particular, the relationships are derived between system variables and the performance of the computer system, and are not user-defined.

Applicants respectfully assert that nowhere does the combination of Dumarot and Seiffert teach, disclose or suggest the present invention as recited in independent Claims 14 and 24, and that these claims overcome the rejection under 35 U.S.C. § 103(a), and are in a condition for allowance. Therefore, Applicants respectfully submit that the combination of Dumarot and Seiffert also does not teach or suggest the additional claimed features of the present invention as recited in Claims 15 and 17-23 that are dependent on allowable base Claim 14 and Claims 25 and 26 that are dependent on allowable base Claim 24. Applicants respectfully

submit that Claims 15, 17-23, 25 and 26 overcome the rejection under 35 U.S.C. § 103(a) as these claims are dependent on allowable base claims.

Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dumarot in view Seiffert, and further yet in view of Mihata. Claim 16 depends from independent Claim 14. Applicants have reviewed the cited reference and respectfully submit that the embodiment of the present invention as recited in Claim 16 is not rendered obvious by the combination of Dumarot in view of Seiffert, further yet in view of Mihata.

As described above, the combination of Dumarot in view of Seiffert does not teach describe or suggest the embodiments of the present invention recited in Claim 14. Moreover, the combination of Dumarot, Seiffert and Mihata fails to teach or suggest the claimed embodiments because Mihata does not overcome the shortcomings of the combination of Dumarot and Seiffert. Applicants understand Mihata to teach a design rules verifying system. Mihata, alone or in combination with Dumarot and Seiffert, does not show or suggest an apparatus for enhancing performance of a computer system, including “program code for deriving relationships between system variables and the performance of said computer system”, as claimed.

Applicants respectfully assert that nowhere does the combination of Dumarot, Seiffert and Mihata, disclose or suggest the present invention as recited in

independent Claim 14, and that Claim 14 is thus in condition for allowance. Therefore, Applicants respectfully submit that the combination of Dumarot, Seiffert and Mihata also does not teach or suggest the additional claimed features of the present invention as recited in Claim 16 that is dependent on allowable base Claim 14. Applicants respectfully submit that Claim 16 overcomes the rejection under 35 U.S.C. § 103(a) as this claim is dependent on an allowable base claim.

Furthermore, Applicants repeat the above request that, in the event that Mihata is again cited by the Examiner in rejecting the claims, in order to fully appreciate the scientific teachings of Mihata, Applicants request that the Examiner provide a complete translation of Mihata in order to fully understand its teachings.

## CONCLUSION

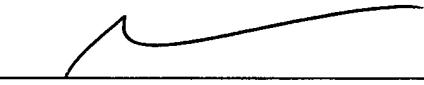
Based on the arguments presented above, Applicants respectfully assert that Claims 1-26 overcome the rejections of record and, therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER, MURABITO & HAO L.L.P.

Dated: 4/5, 2005



John P. Wagner  
Registration No. 35,398

Two North Market Street  
Third Floor  
San Jose, CA 95113  
(408) 938-9060